

AMENDMENT AND RESPONSE TO OFFICE ACTION
U.S. Serial No. 10/636,066

REMARKS

Assignee and the undersigned attorney thank Examiner Duong for review of this patent application and for the allowance of claims 1-8. Claim 9 has been amended above, and Assignee respectfully requests reconsideration of claims 9-14.

The Action rejected claims 9 and 10 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,533,665 to *Sinclair et al.* (“*Sinclair*”). The Action also rejected claims 9 and 10 under 35 U.S.C. § 102(e) as anticipated by U.S. Patent No. 6,781,208 to *Okumura* (“*Okumura*”). Finally, the Action rejected claims 11-14 under 35 U.S.C. § 103(a) as being unpatentable over *Sinclair* in view of U.S. Patent No. 6,150,905 to *Nishijima* (“*Nishijima*”).

Claim Rejections in View of *Okumura*

U.S. Patent No. 6,781, 208 to *Okumura* issued August 24, 2004 from a patent application filed in the U.S. on August 9, 2002. The *Okumura* application was published on February 20, 2003 as U.S. Patent Publication No. 2003/0034542. Under 35 U.S.C. § 102(e), the effective date of *Okumura* as a reference is August 9, 2002. See MPEP §§ 2136, 2136.03. The present application claims priority to U.S. Provisional Application No. 60/401,133, filed on August 5, 2002, which is four days before *Okumura*’s effective date as a reference. Moreover, the provisional application supports the subject matter recited in all of the pending claims. Accordingly, *Okumura* is not a proper reference against this application, and the Examiner should withdraw the § 102(e) rejection of claims 9 and 10 as anticipated by *Okumura*. See MPEP § 2136.05.

Claim Rejections in View of *Sinclair* and *Sinclair* Combined with *Nishijima*

Claims 9-13

The Action rejected claims 9 and 10 as anticipated by *Sinclair* and rejected claims 11-13 as being obvious in view of the combination of *Sinclair* and *Nishijima*. Amended claim 9 is reproduced below:

9. A molded electronic component designed to comply with preset operating characteristics comprising a substrate for holding passive circuit elements and a material molded about the substrate and circuit elements, wherein the interaction of the material and the circuit elements forms a circuit causing the component to perform at the preset operating characteristics.

Sinclair does not anticipate claim 9 because it fails to teach each and every element of claim 9. Specifically, *Sinclair* does not teach or suggest that the interaction of the material and the circuit elements forms a circuit causing the component to perform at the preset operating characteristics.

In describing its invention, *Sinclair* also describes a prior art printed circuit board assembly 10. Col. 4, lines 1-25. The assembly includes printed circuitry 12 and 14 disposed on opposite sides of board 10. Col. 4, lines 1-3. Circuitry 14 is designed for connection to a matrix of leads 18 for subsequent connection to an electrical system. Col. 4, lines 10-13. Plastic planar carrier 20 is molded about the leads 18 to hold the leads in place in the printed circuit board assembly. Col. 4, lines 15-20. Plastic carrier 20 does not contact circuitry 12 at all, while circuitry 14 is merely a circuit path that allows for connection of circuitry 12 to the leads 18. Thus, *Sinclair* merely describes plastic carriers that have been commonly used in electrical components to hold items in place for connection of the leads to a socket. Nothing

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in *Sinclair* teaches or suggests that planar plastic carrier 20 interacts with circuitry 12 or 14, forming a circuit causing the printed circuit board assembly to perform at preset operating characteristics.

Thus, *Sinclair* fails to teach or suggest that the interaction of the material and the circuit elements forms a circuit causing the component to perform at the preset operating characteristics, as recited in amended claim 9. Accordingly, the Examiner should withdraw the rejection of claim 9 under 35 U.S.C. § 102(b), and claim 9 should be allowed. Inasmuch as claims 10-13 depend from and thereby include the limitations of independent claim 9, claims 10-13 should also be allowed for at least such dependencies.

Claim 14

The Action rejected claim 14 as being obvious in view of the combination of *Sinclair* and *Nishijima*. Claim 14 is reproduced below:

14. A method for making an encapsulated electronic component comprising :
- (a) designing a circuit to operate at a first set of operating characteristics;
 - (b) encapsulating the circuit in a particular material;
 - (c) retesting the encapsulated circuit to determine a second set of operating characteristics;
 - (d) determining whether the second set of operating characteristics matches a predetermined set of operating characteristics for the encapsulated component; and
 - (e) modifying, if necessary, the design of the circuit to account for the effect of the encapsulating material so that the overall encapsulated component performs at the predetermined set of operating characteristics.

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With respect to the rejection of claim 14, the Action merely states that "the structure as mentioned above can performed [sic] the method claim." However, claim 14 does not recite a method performed by the structure recited in any of claims 9-13, but rather claim 14 recites a method of making an encapsulated electronic component. *Sinclair* and *Nishijima*, alone or in combination, do not teach or suggest the subject matter recited in claim 14.

For example, *Sinclair* and *Nishijima* do not teach or suggest at least any of the following as recited in claim 14: retesting the encapsulated circuit to determine a second set of operating characteristics; determining whether the second set of operating characteristics matches a predetermined set of operating characteristics for the encapsulated component; or modifying, if necessary, the design of the circuit to account for the effect of the encapsulating material so that the overall encapsulated component performs at the predetermined set of operating characteristics. For these reasons, the Examiner should withdraw the rejection of claim 14 under 35 U.S.C. § 103, and claim 14 should be allowed.

The foregoing is submitted as a full and complete response to the Office Action mailed January 4, 2005. Assignee submits that claims 9-14 are allowable for at least the reasons set forth above, and allowance of these claims is respectfully requested. The preceding arguments in favor of patentability are advanced without prejudice to other bases of patentability. If the Examiner believes there are any issues that can be resolved via a telephone conference, or there are any informalities that can be corrected by an Examiner's amendment, please call Geoffrey Gavin at (404) 815-6046.

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Respectfully submitted,

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